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PATENT

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Applicants: Staub et al.

Serial No.: 09/868,825

Filed: June 21, 2001

For: ACTIVATABLE DOCUMENT AND SYSTEM  
FOR ACTIVATABLE DOCUMENTS

Examiner: N/A

Group Art Unit: N/A

Docket: 182-99 PCT/US

Dated: September 20, 2001

Assistant Commissioner for Patents  
Washington, DC 20231

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an envelope, addressed to: Asst. Commissioner for  
Patents, Washington, D.C. 20231 on September 20, 2001.*

Signature: Carl M. Bryan

**TRANSMITTAL LETTER**

Sir:

Applicants hereby submit a copy of the English translation of the International Preliminary Examination Report for consideration in the above-identified application.

Please note that there was a translation error on page 4 regarding the subject matter of Claim 9. The translation reads, "Therefore, the subject matter of Claim 9 is **not novel** (PCT Article 33(2))." The correct translation is, "Therefore, the subject matter of Claim 9 is **novel** (PCT Article 33(2))."

Respectfully submitted,

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Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

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Applicant's or agent's file reference P2900WO/hs	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP99/10141	International filing date (day/month/year) 20 December 1999 (20.12.99)	Priority date (day/month/year) 24 December 1998 (24.12.98)
International Patent Classification (IPC) or national classification and IPC B42D 15/10		
Applicant OVD KINEGRAM AG		

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1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

☒ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 3 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand 10 July 2000 (10.07.00)	Date of completion of this report 22 February 2001 (22.02.2001)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP99/10141

## I. Basis of the report

1. This report has been drawn on the basis of (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.):

☐ the international application as originally filed.

☒ the description, pages 1-10, as originally filed,  
pages \_\_\_\_\_, filed with the demand,  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_,  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

☒ the claims, Nos. \_\_\_\_\_, as originally filed,  
Nos. \_\_\_\_\_, as amended under Article 19,  
Nos. \_\_\_\_\_, filed with the demand,  
Nos. 1-18, filed with the letter of 20 December 2000 (20.12.2000),  
Nos. \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

☒ the drawings, sheets/fig 1/3-3/3, as originally filed,  
sheets/fig \_\_\_\_\_, filed with the demand,  
sheets/fig \_\_\_\_\_, filed with the letter of \_\_\_\_\_,  
sheets/fig \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

2. The amendments have resulted in the cancellation of:

☐ the description, pages \_\_\_\_\_  
☐ the claims, Nos. \_\_\_\_\_  
☐ the drawings, sheets/fig \_\_\_\_\_

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.  
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V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	2, 5-18	YES
	Claims	1, 3, 4	NO
Inventive step (IS)	Claims	9-18	YES
	Claims	1-8	NO
Industrial applicability (IA)	Claims	1-18	YES
	Claims		NO

2. Citations and explanations

Document US-A-3 833 796 (D1), which is regarded as the closest prior art, discloses (see abstract; column 2, line 17 to column 4, line 35) a document (10) with two six-figure numbers situated side by side. Of course it is also possible to read these two six-figure numbers as three four-figure numbers, the first being called "identification character", the second "document number" and the third "control number". In this manner, the document according to D1 has an at least machine-readable document number on the substrate and a storage field (the location where the third number is printed) for receiving the control number that is machine readable, an optical marking with the machine-readable identification character being placed on the substrate.

The subject matter of Claim 1 does not differ from that of this prior art document (see also Box VIII).

Therefore, the subject matter of Claim 1 is not novel (PCT Article 33(2)).

Dependent Claims 2-8 contain no additional features which, combined with the features of any claim to which they refer, meet the PCT requirements for novelty and inventive

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step. The reasons are as follows:

The additional feature of Claim 2 is only one of several obvious possibilities from which a person skilled in the art would choose in order to solve the problem of interest, without thereby being inventive.

A check according to D1 must also have the additional features of Claims 3 and 4.

The additional features of Claims 5-8 are only one of several obvious possibilities from which a person skilled in the art would choose according to the circumstances in order to store data in a security document, without thereby being inventive.

Document D1, which is regarded as the closest prior art, discloses (see abstract; column 2, line 17 to column 4, line 35) a system from which the subject matter of Claim 9 differs at least in that the system contains a validation device, a calculating unit being contained therein for cryptographic operations with a first secret code for producing a control number by encoding at least two parameters--the document number and the identification character--and a recording means for entering the control number in the at least machine-readable storage field.

Therefore, the subject matter of Claim 9 is ~~not~~ novel (PCT Article 33(2)).

The problem addressed by the present invention can be regarded as creating the possibility to secure a document produced in large quantities such that its authenticity characteristics are not realized until the document is put into circulation so that theft no longer represents a

problem during the time period from production to presentation to the authorized person. The solution suggested to this problem in the present Claim 9 involves an inventive step for the following reasons (PCT Article 33(3)):

There is no indication of the differentiating features in the available prior art.

Claims 10-18 are dependent on Claim 9 and therefore likewise fulfil PCT requirements for novelty and inventive step.

## VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Claim 9 lacks clarity for the following reason:

According to Claim 1, the document is fully realized when the control number is entered into the storage field.

Accordingly, the features of Claim 9 pertaining to the validation device are useless (since the document is already validated). Hence, the system according to Claim 9 should have consisted of a document without a control number.

The feature in device Claim 1

that the control number is first placed in the storage field when the document is put into circulation pertains to a method of using the device and not to the definition of the device using its technical features. Contrary to the requirements of PCT Article 6, the intended limitations do not follow clearly from the claim. The above-mentioned feature is therefore not considered in assessing novelty and inventive step (see Box V above).

Furthermore, the feature that the control number is the result of a cryptographic operation with at least two parameters--the document number and the identification character--and a first secret code does not characterize the subject matter of Claim 1 since it can not be seen from one number on one individual document (as claimed) whether said number does or does not result from such a cryptographic operation since an arbitrary number can be produced through any cryptographic code. Similar considerations apply to the "identification character" and

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

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VIII. Certain observations on the international application

the "document number" because only one single document is claimed. Hence, each of these features means nothing more than "number" (see Box V above).

The wording of the following (amended Claim 1, lines 5-10) is not grammatically correct in the German: "...that to activate a certificate of authenticity..." Furthermore, it remains unclear what the certificate of authenticity is and how it relates to the claimed document.